

DOCKET NO: 197792US-28

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
HIROAKI ISHIZUKA : EXAMINER: TRAN, H.
SERIAL NO: 09/725,511 :
FILED: NOVEMBER 30, 2000 : GROUP ART UNIT: 3693
FOR: METHOD AND SYSTEM OF :
ISSUING ELECTRONIC BILL

APPEAL BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In reply to the Final rejection of June 13, 2007, Applicant appeals the outstanding rejections in the present application.

I. REAL PARTY IN INTEREST

The real party in interest in the present application is the assignee of the present application, Ricoh Company, Ltd., having a place of business at 3-6, Nakamagome 1-chome, Ohta-ku, Tokyo 143-8555 Japan.

II. RELATED APPEALS AND INTERFERENCES

Appellant, Appellant's legal representative, and the assignee are not aware of any other interferences, judicial proceedings, or related appeals that may be related to, directly affect or be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-43 are pending in this application. Each of claims 1-43 stands rejected. Each of the rejections of claims 1-43 is being appealed.

IV. STATUS OF AMENDMENTS

No amendment was filed subsequent to the Final rejection of June 13, 2007. A Response was filed on September 13, 2007, but that Response did not present any claim amendments but only arguments to the allowability of the claims over the applied art. The Advisory Action of October 1, 2007 did not indicate any status as to whether that Response would be entered or not.

For the purpose of the appeal the claims being appealed are the claims as presented in the Amendment filed March 19, 2007 and addressed in the Final rejection of June 13, 2007.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention relates to the use of information obtained from an off-line transaction for use of an analysis of characteristics of a purchaser when considering whether or not to grant authorization for a subsequent on-line transaction. (Specification at page 1, lines 8-11).

The present inventor recognized that in electronic billing systems a person must often enter their billing and personal information at least once, and that it may be preferable if the user did not have to go through the tedious task of himself or herself entering all of their billing information. (Specification at page 1, lines 18-28.)

The present invention overcomes such deficiencies of known billing systems as, in the present invention, at least some information of or about the user obtained from an off-line

transaction is utilized for a subsequent on-line transaction. (Specification at page 2, lines 2-5.)

Independent Claim 1

According to a method for communicating according to claim 1, a customer's financial information is stored in a supplier computer system based on an off-line transaction between a customer and the supplier. (See the specification at Figure 5, step S402, the present specification at page 10, line 22 to page 11, line 5, the supplier computer system 200 and the databases 224, 226, 228.) An on-line purchase by a customer is begun with the supplier, and information of that beginning is communicated to a server computer by the customer. (See step 450 and Figure 6A and 6D in the specification, server computer 204, and the specification at page 12, line 15 et seq.)

The method and system can then determine that the customer is an acceptable credit risk for the on-line purchase using the customer's financial information in the supplier computer system 200, and which is based on the off-line transaction. (See step S404 in Figure 4 in the specification, and the specification at page 11, line 6 et seq., and the supplier computer system 200.)

Further, information can then be communicated to the customer that the on-line purchase has been approved, after the determining determines that the customer is an acceptable risk. (See the specification at page 14, line 13 et seq., Figure 9, and the display screen 650 which operates as part of a communication.)

Independent Claim 24

According to a system for communicating according to claim 24, a customer's financial information is stored in a supplier computer system based on an off-line transaction

between a customer and the supplier. (See the specification at Figure 5, step S402, the present specification at page 10, line 22 to page 11, line 5, the supplier computer system 200 and the databases 224, 226, 228.) An on-line purchase by a customer is begun with the supplier, and information of that beginning is communicated to a server computer by the customer. (See step 450 and Figure 6A and 6D in the specification, server computer 204, and the specification at page 12, line 15 et seq.)

The method and system can then determine that the customer is an acceptable credit risk for the on-line purchase using the customer's financial information in the supplier computer system 200, and which is based on the off-line transaction. (See step S404 in Figure 4 in the specification, and the specification at page 11, line 6 et seq., and the supplier computer system 200.)

Further, information can then be communicated to the customer that the on-line purchase has been approved, after the determining determines that the customer is an acceptable risk. (See the specification at page 14, line 13 et seq., Figure 9, and the display screen 650 which operates as part of a communication.)

Dependent Claims 2 and 25

According a further feature according to dependent claims 2 and 25, the customer's financial information that is stored is based on a lease. (Specification at page 8, lines 5-10).

Dependent Claims 3 and 26

According to further features according to dependent claims 3 and 26, the customer's financial information that is stored may be based on a lease of an image forming device. (Specification at page 8, lines 5-10).

Dependent Claims 4, 5 and 27, 28

According to a further feature according to dependent claims 4 and 27, the customer's financial information that is stored may be on a purchase of an image forming device, and as further defined in dependent claims 5 and 27, that image forming device can be at least one of a copier and a facsimile machine (Specification at page 8, lines 5-10).

Dependent Claims 6, 7, and 27, 28

According to further features according to dependent claims 6, 7, 27, and 28, a determination can be made that the customer is an acceptable credit risk based on the lease of a machine by the customer (Specification at page 11, line 6 *et seq.*), and further based on up-to-date payments on the lease (Specification at page 11, line 14 *et seq.*).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-7, 16-19, 22-30, 39-42, 45, and 46 stand rejected under 35 U.S.C. §103(a) as unpatentable over U.S. patent 6,055,573 to Gardenswartz et al. (herein "Gardenswartz") in view of U.S. patent 6,092,053 to Boesch et al. (herein "Boesch"). Claims 8-15, 20-21, 31-38, and 43-44 stand rejected under 35 U.S.C. §103(a) as unpatentable over Gardenswartz in view of Boesch and further in view of Official Notice.

VII. ARGUMENT

Independent Claims 1 and 24

The above-noted rejections rely on Gardenswartz as the primary reference and then further cite Boesch and Official Notice. The outstanding rejections recognize that Gardenswartz "discloses a method, system and computer program product for delivering a

targeted advertisement based on a customer's off-line purchase history".¹ In that respect applicant notes Gardenswartz is directed to subject matter not at all even related to the claimed invention.

As noted above, the system and method of the claims determine whether a customer is an acceptable credit risk for an on-line purchase using the customer's financial information based on a prior off-line transaction. Such a system as claimed is thereby directed to a type of "credit exposure management", which allows a supplier to determine a credit risk of customers for sales. Gardenswartz is not directed to any type of similar system. Instead, Gardenswartz is directed to delivering a targeting advertisement based on a customer database. Gardenswartz merely utilizes a server that can provide a targeted price offer advertisement to a customer, but Gardenswartz does not disclose or suggest any determination of whether the customer is an acceptable credit risk for an on-line purchase, based on a prior off-line transaction.

Independent claim 1 specifically recites an operation of "determining whether the customer is an acceptable credit risk for the on-line purchase using the customer's financial information in the supplier computer system and which is based on the off-line transaction". Independent claim 24 recites a similar feature. That feature is believed to clearly distinguish over Gardenswartz which was cited as meeting that claimed feature.

In further detail, with respect to the above-noted feature the outstanding rejection cites Gardenswartz at "figure 8/element 70, col. 12, lines 65-67, figure 10/element 1000, col. 15, lines 19-40".² Applicant traverses that grounds for rejection and notes the cited disclosures in Gardenswartz are not at all related to the above-noted claimed feature.

At Figure 8, element 70, and the corresponding description at column 12, lines 65-67 Gardenswartz notes sending purchase history criterion to an analytics unit. However, that

¹ Final Office Action of June 13, 2007, page 3, prenumbered paragraph 8.

² Office Action of June 13, 2007, page 3, prenumbered paragraph 9, lines 10-11.

operation in Gardenswartz is not directed to determining whether a customer is an acceptable credit risk for an on-line purchase. Instead, that operation in Gardenswartz is directed to determining the targeted ad to send to the customer. That is evident from steps 74-76 in Figure 8 that are all directed to generating a targeted ad based on the purchase history criterion. Thereby, that noted disclosure in Gardenswartz is not at all directed to the claimed features of determining a credit risk of a customer for a subsequent on-line purchase.

Further, at Figure 10, element 1000, and the corresponding disclosure at column 15, lines 19-40 Gardenswartz indicates the analytics unit 16 searches a purchase history database for consumers and then ultimately offers the consumer a new “value contract” in step 1014 based on their purchase history. However, that disclosure in Gardenswartz is also not directed to the claimed features of determining the credit risk of a consumer for an on-line purchase subsequent to an off-line transaction. In that respect applicant also notes the outstanding grounds for rejection appears to be completely misconstruing what a “value contract” is in Gardenswartz. Gardenswartz specifically states:

The value contract offers the consumer a reward for complying with a given type of behavior. This behavior may be a predefined change in behavior or continuance of an established behavior. Preferably, the behavior is defined as a minimum number of purchases that must be made within a predetermined time period...Once a consumer wins a reward, the reward is preferably presented to the consumer in a retail store. Thus, the reward provides an incentive for the consumer to visit the retail store.³

Thereby, in Gardenswartz the “value contract” is nothing more than an in store promotion for a consumer. Such a disclosure in Gardenswartz is in fact also merely directed to providing a consumer with a targeted advertisement or “value contract” based on their purchase history. That disclosure in Gardenswartz is not at all directed to determining the credit risk of the consumer for an on-line transaction based on and subsequent to an off-line

³ Gardenswartz at column 3, line 61 to column 4, line 12.

transaction. Applicant also point out the “value contract” in Gardenswartz is directed to an opposite objective as in the claimed invention. The “value contract” in Gardenswartz is directed to providing a consumer with a reward as an incentive for the consumer to visit a retail store. The claims are clearly directed to an “on-line transaction”, not an in-store transaction, subsequent to an off-line transaction. Thereby, Gardenswartz in fact *teaches away* from the above-noted claimed feature.

In such ways, applicant respectfully submits the outstanding rejection is misconstruing the teachings in Gardenswartz as Gardenswartz does not in fact disclose or suggest “determining whether the customer is an acceptable credit risk for the on-line purchase using the customer’s financial information in the supplier computer system and which is based on the off-line transaction”, as recited in the claims.

Moreover, no teachings in Boesch are believed to cure the above-noted deficiencies in Gardenswartz. In that respect applicant also reiterates that Gardenswartz is directed to a contrary objective as in the claimed invention and thus could not have been modified by Boesch to meet the above-noted claimed features.

Applicant also submits the outstanding rejection is misconstruing several features in the dependent claims relative to the applied art.

Dependent Claims 2 and 25

With respect to dependent claims 2 and 25, the outstanding rejection also cites the disclosure in Gardenswartz to the “value contract”.⁴ As discussed above the “value contract” in Gardenswartz is not at all directed to an off-line transaction of a lease.

As noted above, the “value contract” in Gardenswartz merely provides a consumer with a reward as an incentive for the consumer to visit a retail store. Such a “value contract”

⁴ Office Action of June 13, 2007, page 4, prenumbered paragraph 12.

is not a lease transaction. Thereby, dependent claims 2 and 25 even further distinguish over Gardenswartz.

Dependent Claims 3 and 26

With respect to dependent claims 3 and 26, as the “value contract” in Gardenswartz is not at all directed to a lease, it clearly is not even further directed to a “lease of an image forming device” as further recited in those claims. Thereby, dependent claims 3 and 26 also even further distinguish over Gardenswartz.

Dependent Claims 4, 5, and 27, 28

Dependent claims 4, 5 and 27, 28 further recite that the customer’s financial information is based on a purchase of an image forming device (Claims 4 and 27), which may be a copier or facsimile (Claims 5 and 28). Gardenswartz does not disclose or suggest such features and the basis for the rejection has not even actually addressed such features.

With respect to claims 4, 5 and 27-28, the outstanding rejection merely appears to indicate Gardenswartz could include the features recited therein. However, again applicant notes Gardenswartz is not directed to the claimed features of utilizing a specific type of off-line transaction to determine a customer’s credit risk for a subsequent on-line purchase. Thereby, Gardenswartz in fact teaches away from the features in dependent claims 4, 5 and 27-28.

Dependent Claims 6, 7 and 29, 30

With respect to dependent claims 6, and 29, those claims further recite that determining whether a customer is an acceptable credit risk based on the existence of a lease of a machine by the customer, and dependent claims 7 and 30 further define also evaluating

“up-to-date payments on the lease”. Gardenswartz fails to disclose or suggest any such features, particularly since as discussed above in detail Gardenswartz does not provide any determination as to the credit worthiness of a customer.

As also discussed above in detail, Gardenswartz teaches away from the features therein.

Dependent Claims 8-15, 20-21, 31-38, and 43-44

With respect to dependent claims 8-15, 20-21, 31-38, and 43-44, applicant previously traversed the basis for the Official Notice and requested that prior art be cited for the features recited therein. That has not even been addressed. In that respect applicant reiterates Gardenswartz teaches away from the claimed features, and applicant note no clear motivation has been set forth to modify Gardenswartz to meet such further claim features in view of the art to be cited for the propositions for which Official Notice was taken.

IX. CONCLUSION

For the above reasons it is respectfully submitted that the above-noted rejections pending in the Final Office Action are improper and must be REVERSED, as thereby each of claims 1-46 is allowable over the previously applied art.

Respectfully submitted,

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CLAIMS APPENDIX

Claim 1 (Previously Presented): A method of communicating, comprising the steps of:

storing a customer's financial information in a supplier computer system based on an off-line transaction of a completed purchase or lease of equipment between a customer and a supplier;

beginning an on-line purchase, subsequent to the completed off-line transaction, by the customer with the supplier and communicating to a server computer by the customer;

determining whether the customer is an acceptable credit risk for the on-line purchase using the customer's financial information in the supplier computer system and which is based on the off-line transaction;

communicating to the customer that the on-line purchase has been approved, when said determining step determines that the customer is an acceptable credit risk.

Claim 2 (Original): A method according to claim 1, wherein said step of storing comprises:

storing the customer's financial information based on a lease.

Claim 3 (Previously Presented): A method according to claim 1, wherein said step of storing comprises:

storing the customer's financial information based on a lease of an image forming device.

Claim 4 (Original): A method according to claim 1, wherein said step of storing comprises:

storing the customer's financial information based on a purchase of an image forming device.

Claim 5 (Original): A method according to claim 4, wherein said step of storing comprises:

storing the customer's financial information based on a purchase of at least one of a copier and a facsimile machine.

Claim 6 (Original): A method according to claim 1, wherein said determining step comprises:

determining that the customer is an acceptable credit risk based the existence of a lease of a machine by the customer.

Claim 7 (Previously Presented): A method according to claim 1, wherein said determining step comprises:

determining that the customer is an acceptable credit risk based the existence of a lease of a machine by the customer and up-to-date payments on the lease.

Claim 8 (Original): A method according claim 1, wherein said step of communicating to the customer comprises:

communicating that the on-line purchase which is a purchase of supplies for an image forming device which has been obtained through the off-line transaction has been approved.

Claim 9 (Original): A method according to claim 1, further comprising the step of: issuing a bill for the on-line purchase.

Claim 10 (Original): A method according to claim 9, wherein said step of issuing a bill comprises:

issuing an electronic bill for the on-line purchase.

Claim 11 (Original): A method according to claim 10, wherein said step of issuing a bill comprises:

transmitting the electronic bill for the on-line purchase by email.

Claim 12 (Original): A method according to claim 10, wherein step of issuing a bill comprises:

notifying said customer that said electronic bill is stored at an Internet site.

Claim 13 (Original): A method according to claim 12, wherein said notifying step comprises:

notifying said customer by an electronic mail message that said electronic bill is stored at the Internet site.

Claim 14 (Original): A method according to claim 10, wherein said step of issuing a bill comprises:

issuing a single electronic bill for both the on-line purchase and a lease corresponding to the off-line transaction.

Claim 15 (Original): A method according to claim 9, further comprising the step of:

printing a paper bill for the on-line purchase, and sending the paper bill to the customer.

Claim 16 (Original): A method according to claim 9, further comprising the step of:
debiting a pre-registered bank account by an amount corresponding to the on-line transaction.

Claim 17 (Original): A method according to claim 16, wherein said debiting step comprises:

debiting a pre-registered bank account by an amount corresponding to the on-line transaction and a payment for the off-line transaction.

Claim 18 (Original): A method according to claim 1, further comprising the step of:
charging a third party credit card of the customer for the on-line transaction.

Claim 19 (Original): A method according to claim 1, further comprising the step of:
issuing a paper bill for said transaction if said financial information is not valid.

Claim 20 (Original): A method according to claim 9, wherein said step of issuing comprises:

issuing the bill for the on-line purchase according to a predetermined billing cycle which is greater than one day.

Claim 21 (Original): A method according to claim 9, wherein said step of issuing comprises:

issuing a single bill for plural transactions occurring over a time period.

Claim 22 (Original): A method according to claim 1, further comprising the step of:
purchasing a product through the on-line purchase, the product being different from a product obtained through the off-line transaction.

Claim 23 (Original): A method according to claim 22, wherein said step of purchasing comprises:

purchasing the product through the on-line purchase which is for use with the product obtained through the off-line transaction.

Claim 24 (Previously Presented): A system for communicating, comprising:
means for storing a customer's financial information in a supplier computer system based on an off-line transaction of a completed purchase or lease of equipment between a customer and a supplier;
means for beginning an on-line purchase, subsequent to the completed off-line transaction, by the customer with the supplier and communicating to a server computer by the customer;
means for determining whether the customer is an acceptable credit risk for the on-line purchase using the customer's financial information in the supplier computer system and which is based on the off-line transaction; and
means for communicating to the customer that the on-line purchase has been approved, when the means for determining determines that the customer is an acceptable credit risk.

Claim 25 (Original): A system according to claim 24, wherein said means for storing comprises:

means for storing the customer's financial information based on a lease.

Claim 26 (Previously Presented): A system according to claim 24, wherein said means for storing comprises:

means for storing the customer's financial information based on a lease of an image forming device.

Claim 27 (Original): A system according to claim 24, wherein said means for storing comprises:

means for storing the customer's financial information based on a purchase of an image forming device.

Claim 28 (Original): A system according to claim 27, wherein said means for storing comprises:

means for storing the customer's financial information based on a purchase of at least one of a copier and a facsimile machine.

Claim 29 (Original): A system according to claim 24, wherein said means for determining comprises:

means for determining that the customer is an acceptable credit risk based the existence of a lease of a machine by the customer.

Claim 30 (Previously Presented): A system according to claim 24, wherein said means for determining comprises:

means for determining that the customer is an acceptable credit risk based the existence of a lease of a machine by the customer and up-to-date payments on the lease.

Claim 31 (Original): A system according claim 24, wherein said means for communicating to the customer comprises:

means for communicating that the on-line purchase which is a purchase of supplies for an image forming device which has been obtained through the off-line transaction has been approved.

Claim 32 (Original): A system according to claim 24, further comprising:

means for issuing a bill for the on-line purchase.

Claim 33 (Original): A system according to claim 32, wherein said means for issuing a bill comprises:

means for issuing an electronic bill for the on-line purchase.

Claim 34 (Original): A system according to claim 33, wherein said means for issuing a bill comprises:

means for transmitting the electronic bill for the on-line purchase by email.

Claim 35 (Original): A system according to claim 33, wherein means for issuing a bill comprises:

means for notifying said customer that said electronic bill is stored at an Internet site.

Claim 36 (Original): A system according to claim 35, wherein said means for notifying comprises:

means for notifying said customer by an electronic mail message that said electronic bill is stored at the Internet site.

Claim 37 (Original): A system according to claim 33, wherein said means for issuing a bill comprises:

means for issuing a single electronic bill for both the on-line purchase and a lease corresponding to the off-line transaction.

Claim 38 (Original): A system according to claim 32, further comprising:

means for printing a paper bill for the on-line purchase.

Claim 39 (Original): A system according to claim 32, further comprising:

means for debiting a pre-registered bank account by an amount corresponding to the on-line transaction.

Claim 40 (Original): A system according to claim 39, wherein said means for debiting comprises:

means for debiting a pre-registered bank account by an amount corresponding to the on-line transaction and a payment for the off-line transaction.

Claim 41 (Original): A system according to claim 24, further comprising:

means for charging a third party credit card of the customer for the on-line transaction.

Claim 42 (Original): A system according to claim 24, further comprising:
means for issuing a paper bill for said transaction if said financial information is not valid.

Claim 43 (Original): A system according to claim 32, wherein said means for issuing comprises:

means for issuing the bill for the on-line purchase according to a predetermined billing cycle which is greater than one day.

Claim 44 (Original): A system according to claim 32, wherein said means for issuing comprises:

means for issuing a single bill for plural transactions occurring over a time period.

Claim 45 (Original): A system according to claim 24, further comprising:
means for purchasing a product through the on-line purchase, the product being different from a product obtained through the off-line transaction.

Claim 46 (Original): A system according to claim 45, wherein said means for purchasing comprises:

means for purchasing the product through the on-line purchase which is for use with the product obtained through the off-line transaction.

EVIDENCE APPENDIX

None

RELATED PROCEEDINGS APPENDIX

None